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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,639	08/10/2001	Michihiro Izumi	862.C2341	4424
5514	7590	04/09/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			AFSHAR, KAMRAN	
			ART UNIT	PAPER NUMBER
			2681	5

DATE MAILED: 04/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/925,639

Applicant(s)

IZUMI, MICHIIHIRO

Examiner

Kamran Afshar, 703-305-7373

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/14/01
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Toyoda (U.S. Patent. 5,825,505).

With respect to claim 1, Toyoda disclose a communication apparatus having means for connecting to a communication line (See e.g. 110-110 of Fig. 1 Co. 4, Lines 19-32), and capable of communication with a radio terminal not via communication line (See e.g. facsimile main body 41, Co. 6, Lines 41-54), first means for performing radio communication in a first mode (See e.g. 14 of Fig. 1, Co.3, Line 65 – Co. 4, Lines 5); second means for performing radio communication in a second mode (See e.g. 28 of Fig. 2, Co. 5, Lines 35-40) ; control means for exerting control (See CPU 11 of Fig. 1, CPU 21 of

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Fig. 2) to use first means in the case where radio terminal communicates communication line (See e.g. Co. 3, Lines 48-56), and to use second means in the case where radio terminal communicates with another terminal not by way of communication line (See e.g. Co. 5, Lines 3-12 & Entire Document).

Regarding claim 2, Toyoda disclose an apparatus main body having means for connecting to communication line (See e.g. facsimile main body 41, Co. 6, Lines 41-54); and a scanner having an image reading function and removable (See e.g. Fig. 4A-4B) from apparatus main body (See e.g. Co. 16, Lines 5-9), wherein scanner has second means (See e.g. 28 of Fig. 2, Co. 5, Lines 35-40), and apparatus main body has first means (See e.g. 14 of Fig. 1, Co.3, Line 65 – Co. 4, Lines 5 & Entire Document).

Regarding claim 3, Toyoda disclose an apparatus main body having means for connecting to communication line (See e.g. facsimile main body 41, Co. 6, Lines 41-54); and a scanner having an image reading function and removable (See e.g. Fig. 4A-4B) from apparatus main body (See e.g. Abstract, Co. 16, Lines 5-9), wherein both scanner and apparatus main body have second means (See e.g. Co. 6, Lines, Fig. 37 & Entire Document).

3. Claims 1, 4, 6-8, 10-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Palmer (US. Patent 6,295,461 B1).

With respect to claims 1, 8, Palmer discloses a method, steps and / or a communication apparatus having (See i.e. central host processor, Co. 1, Lines 10-35, network access controller, Co. 2, Lines 50-60, and / or central computer controller, See Co. 4, Lines 10-15) means for connecting to a communication line (See i.e. wired line 2 of Fig. 10) and capable of communication with a radio terminal not via communication line (See i.e. RF Signal or By Wireless, See e.g. 2-4 of Fig. 1, Co. 4, Lines 10-29), first means for performing radio communication in a first mode (See e.g. wired medium 2 and / or nodes 3 of fig. 1); second means for performing radio communication in a second mode (See e.g. access point 5 including an R) receiver / transmitter); control means for exerting control (See e.g. controller 4 of Fig. 1), to use first means in the case where radio terminal communicates via communication line, and to use second means in the case where radio terminal communicates with another terminal not by way of communication line (See Abstract, Co. 1, Lines 11-35, Co. 2, Lines 50-67, Co. 4, Lines 10-29 & Entire Document).

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Regarding claim 4, Palmer discloses first mode is a time division multiplex communication mode, and second mode is a frequency hopping mode (See co. 2, Lines 44-67).

With respect to claims 6, 10, Palmer discloses a method, steps, and / or a communication apparatus having (See i.e. central host processor, Co. 1, Lines 10-35, network access controller, Co. 2, Lines 50-60, and / or central computer controller, See Co. 4, Lines 10-15) means for connecting to a communication line (See i.e. wired line 2 of Fig. 10) and capable of communication with a plurality of radio terminals not via communication line (See e.g. 6-9 of Figs. 1), comprising: storage means (See e.g. 9 of Fig. 1, Co. 5, Lines 3-13) for storing information indicating whether or not each individual radio terminal is connectable to a narrow-band radio communication line and/or a wide-band radio communication line (See e.g. Co. 6, Lines 15-33); and means for, when sending data to radio terminal, sending the data by determining the radio communication line to be used based on information corresponding to radio terminal as the destination stored by storage means (See Co. 5, Lines 3-54 & Entire Document).

With respect to claims 7, 11, Palmer discloses a control method and / or a communication apparatus having (See i.e. central host processor, Co. 1, Lines 10-35, network access controller, Co. 2, Lines 50-60, and / or central computer controller, See Co. 4, Lines 10-15) means for connecting to a communication line (See i.e. wired line 2 of Fig. 10), comprising: first means for performing radio communication in a first mode (See e.g. 7 of Fig. 1); second means for performing radio communication in a second mode (See; selection means for selecting first means or second means according to whether (See e.g. Co. 2, Lines 44-67) or not the data to be transmitted to radio terminal (See e.g. Co. 3, Lines 33-39) is the data received from the communication line (See e.g. Co. 4, Lines 10-29).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 4-5, 9 are rejected under 35 U.S.C. 103(a) as being obvious over Toyoda (U.S. Patent 5,825,505) in view of Izumi (U.S. Patent 6,288,800 B1).

Regarding claim 4, Toyoda disclosed everything as discussed above in claim 1. However, Toyoda was silent first mode is a time division multiplex communication mode, and second mode is a frequency hopping mode. In the same field of endeavor, Izumi teaches that first mode is a time division multiplex communication mode (See e.g. Co. 7, Lines 47-58 & Figs. 7-8), and second mode is a frequency hopping mode (See e.g. Fig. Co. 3, Lines 16-22). Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention to provide above teaching of Izumi to Toyoda providing the originating terminal and the destination terminal store the identical hopping pattern and synchronize timing to change frequencies by synchronizing to each other as suggested by Izumi (see e.g. Co. 1, lines 33-35).

With respect to claims 5, 9, Toyoda teaches control method and / or a communication apparatus main body having means for connecting to communication line (See e.g. facsimile main body 41, Co. 6, Lines 41-54); and a scanner having an image reading function and removable (See e.g. Fig. 4A-4B) from apparatus main body (See e.g. Co. 16, Lines 5-9). In the same field of endeavor, Izumi explicitly teaches wherein scanner (See e.g. Co. 1, Lines 14-43, 105 of Fig. 1, 303, of Fig. 3 & 5, Co. 3, Lines 25-50, Co. 3, Line 55-67) comprises: means (See i.e. 201, 204 of Fig. 2) for selecting whether to print (206, 208 of Fig. 2, 603 of Fig. 6, & 8) read image or to communicate it to communication line; and means for sending to apparatus main body an instruction according to selection results together with an image read by the scanner by radio communication, and apparatus main body (See e.g. 302 of Figs. 3- 4, Co. 4, Lines 31-46, 602 of Fig. 7, Flow charts of Figs. 11-12, 15, 17) comprises: means for printing (a received image which received from the scanner; and means for sending the received image to the communication line (See e.g. Co. 1, Lines 47-54 & Entire Document). Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention to provide above teaching of Izumi to Toyoda facilitate a the digital camera (i.e. scanner) which can be directly connected to the dedicated printer or a dedicated modem via the printer interface or the communication adapter interface to select printing an image or transmit it to the communication line as suggested Izumi (See Co. 1, Lines 47-51).

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6. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being obvious over Palmer (US. Patent 6,295,461 B1) In view of Toyoda (U.S. Patent. 5,825,505).

Regarding claims 2-3, Palmer disclosed everything as discussed above in claim 1. Further, Palmer discloses a scanner having an image reading function (See e.g. 8 of Fig. 1, Co. 4, Lines 52- Co. 5, Line 2). Palmer did not explicitly teach an apparatus main body having means for connecting to communication line; and a scanner having an image reading function and removable from apparatus main body, wherein scanner has second means, and apparatus main body has first means. In the same field of endeavor, Toyoda teaches an apparatus main body having means for connecting to communication line (See e.g. facsimile main body 41, Co. 6, Lines 41-54); and a scanner having an image reading function and removable (See e.g. Fig. 4A-4B) from apparatus main body (See e.g. Co. 16, Lines 5-9), wherein scanner has second means (See e.g. 28 of Fig. 2, Co. 5, Lines 35-40), and apparatus main body has first means (See e.g. 14 of Fig. 1, Co.3, Line 65 – Co. 4, Lines 5 & Entire Document). Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention to provide above teaching of Izumi in view of Toyoda facilitating an apparatus main body having means for connecting to communication line (See e.g. facsimile main body 41, Co. 6, Lines 41-54); and a scanner having an image reading function and removable (See e.g. Fig. 4A-4B) from apparatus main body (See e.g. Abstract, Co. 16, Lines 5-9), wherein both scanner and apparatus main body have second means (See e.g. Co. 6, Lines, Fig. 37 & Entire Document).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Joo-Seung Park (U.S. Patent 6,246,489 B1), Method of and apparatus for recording a telephone conversation in a cordless facsimile system.


Any inquiry concerning this communication or earlier communication from the examiner should be directed to Kamran Afshar whose telephone number is (703) 305-7373. The examiner can be reached on Monday-Friday.

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If attempts to reach the examiner by the telephone are unsuccessful, the examiner's supervisor, Gary, Erika A. can be reached @ (703) 308-0123. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306 for all communications.



Kamran Afshar


ERIKA GAFF
PATENT EXAMINER